



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,024	11/15/2001	Takashi Futagawa	56694	5035

7590 01/15/2003

Dike, Bronstein, Roberts & Cushman
Intellectual Property Practice Group of
Edwards & Angell, LLP
P.O. Box 9169
Boston, MA 02209

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application No.

10/002,024

Applicant(s)

FUTAGAWA ET AL.

Examiner

Christopher P Bruenjes

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 8, 11, 13, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 17 and 18, the limitation of the outermost layer having a shape factor and the method of determining the shape factor is indefinite and vague. It is not understood whether the outermost layer contains a shape factor or if the shape factor is a measurement. It is also not understood if "a peak shape of Raman spectrum" is being claimed as a component of the outermost layer or merely describing the method of determining frequency peaks that are used to determine the shape factor. Shape factor is not defined to a point that enables one of ordinary skill in the art to understand what is referred to as a shape factor. Note that methods of measuring articles for determining certain values receive little

Art Unit: 1772

patentable weight in article claims, because articles are defined by structure not merely stating intended results and special methods to determine the intended results.

Claim 8 recites the limitation "said gas-barrier resin layer" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 8 is dependent upon claim 5, which does not define a gas-barrier resin layer; claim 8 should probably be dependent upon claim 7.

Claim 11 recites the limitation "each of said adhesive layers" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claim lists only an innermost and outermost layer with adhesive between, therefore there is only one adhesive layer.

Regarding claim 13, the claim is a process limitation in an article claim, which receives little patentable weight. Article claims are defined solely by the structure of the article and not by intended outcomes of process limitations. Therefore, claim 13 is defined as a laminated film according to claim 1 made by co-extrusion.

Regarding claim 16, the limitation "used for packaging foods" is a limitation based on intended use, which receives little patentable weight in an article claim. Articles are defined by the structure of the article not by intended use.

Art Unit: 1772

Use claims require definitive steps in order to define a process of using the article. A process and article cannot be claimed in the same claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Futagawa (JP 11-077937).

Futagawa anticipates a laminated film produced by a co-extrusion inflation method (p.3, 1.27-30) comprising an outermost layer comprising polybutylene terephthalates homopolymers or copolymer containing an anti-blocking agent made of organic fine particles, an innermost layer comprising a heat-sealing resin, and a gas barrier resin layer interposed between the outermost layer and the innermost layer (see abstract). The anti-blocking agent is contained in an amount of 100 to 10,000ppm based on the resin (p.2, 1.5-6). The heat-sealing resin is one of the following: a high-density polyethylene, a

Art Unit: 1772

medium density polyethylene, a low-density polyethylene, polypropylene, an ethylene vinyl acetate copolymer, an ethylene methacrylate copolymer, an ethylene ethyl acrylate copolymer, an ethylene ethyl-acrylate copolymer, an ethylene ethyl-methacrylate copolymer, adhesive polyethylene, an ionomer resin, EVOH, or linear low-density polyethylene copolymer (p.2, 1.25-30). The gas barrier resin layer is formed of polyamide, EVOH, PET, PEN, or polycarbonate (p.2, 1.7-11). The film further comprises an adhesive resin layer composed of a modified polyolefin resin, which is interposed between the respective layers (p.1, 1.31-32). The thicknesses of the layers are the outermost layer is 5-100 micrometers preferably 10-30 micrometers, the innermost layer is 30-70 micrometers, the gas barrier resin layer is 10-70 micrometers, and the adhesive resin layers are 2-30 micrometers (p.3, 1.22-26). The film has a heat-shrinkage percentage in each of longitudinal direction and transverse direction of the film is not more than 5% (p.3, 1.39-41). The film is produced by a water-cooled fabricating method of co-extrusion (p.3, 1.27-39). The film is formed into a packaging bag for packaging foods by heat sealing (p.3, 1.42-48). The outermost layer inherently has a shape factor of not less than 2.2, because the layer is made of the same composition, produced by the same method, and intended for the

Art Unit: 1772

same use as the instant invention. The method of determining the shape factor in the article claim receives little patentable weight because it is a process limitation with no structure. Also the packaging bag formed from the film inherently has a haze of 2-20%, because the film is comprised of the same layers, produced by the same method, and intended for the same use, and the film is heat-sealed to form the packaging bag by the same method as the instant invention. Structurally the two films are identical therefore, the Futagawa's film would have a haze of 2-20%.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Futagawa (JP 11-077937).

Futagawa teaches a laminated film produced by a co-extrusion inflation method (p.3, 1.27-30) comprising an

Art Unit: 1772

outermost layer comprising polybutylene terephthalates homopolymers or copolymer containing an anti-blocking agent made of organic fine particles, an innermost layer comprising a heat-sealing resin, and a gas barrier resin layer interposed between the outermost layer and the innermost layer (see abstract). The anti-blocking agent is contained in an amount of 100 to 10,000ppm based on the resin (p.2, 1.5-6). The heat-sealing resin is one of the following: a high-density polyethylene, a medium density polyethylene, a low-density polyethylene, polypropylene, an ethylene vinyl acetate copolymer, an ethylene methacrylate copolymer, an ethylene ethyl acrylate copolymer, an ethylene ethyl-acrylate copolymer, an ethylene ethyl-methacrylate copolymer, adhesive polyethylene, an ionomer resin, EVOH, or linear low-density polyethylene copolymer (p.2, 1.25-30). The gas barrier resin layer is formed of polyamide, EVOH, PET, PEN, or polycarbonate (p.2, 1.7-11). The film further comprises an adhesive resin layer composed of a modified polyolefin resin, which is interposed between the respective layers (p.1, 1.31-32). The thickness of the layers are the outermost layer is 5-100 micrometers preferably 10-30 micrometers, the innermost layer is 30-70 micrometers, the gas barrier resin layer is 10-70 micrometers, and the adhesive resin layers are 2-30 micrometers (p.3, 1.22-26). The film has a

Art Unit: 1772

heat-shrinkage percentage in each of longitudinal direction and transverse direction of the film is not more than 5% (p.3, 1.39-41). The film is produced by a water-cooled fabricating method of co-extrusion (p.3, 1.27-39). The film is formed into a packaging bag for packaging foods by heat sealing (p.3, 1.42-48). The outermost layer obviously has a shape factor of not less than 2.2, because the layer is made of the same composition, produced by the same method, and intended for the same use as the instant invention. The method of determining the shape factor in the article claim receives little patentable weight because it is a process limitation with no structure. Also the packaging bag formed from the film obviously has a haze of 2-20%, because the film is comprised of the same layers, produced by the same method, and intended for the same use, and the film is heat-sealed to form the packaging bag by the same method as the instant invention. Structurally the two films are identical therefore, the Futagawa's film would have a haze of 2-20%.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to arrive at measured values of the shape factor of less than 2.2 and a haze of 2-20% for Futagawa's film, because the film comprises the same layers, with the same composition,

Art Unit: 1772

produced by the same method, and intended for the same use, and the film is heat-sealed to form the packaging bag by the same method as the instant invention. Measurements of the same article have the same results, and merely testing an article by different methods is given little patentable weight in article claims, articles are defined only by structure.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Futagawa (JP 2000-025184); Bowen et al (USPN 6,120,860); Kunz et al (USPN 5,387,449); Yoshii et al (USPN 6,146,726); Wnuk et al (USPN 5,391,423).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned

Art Unit: 1772


are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

January 9, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/10/03